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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,668	06/01/2001	Darrel D. Cherry	10008156-1	2901

7590 08/24/2005

HEWLETT-PACKARD COMPANY  
Intellectual Property administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/872,668

Applicant(s)

CHERRY ET AL

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Response to Amendment*

This office action is in response to amendment filed February 7, 2005. Claims 1 and 9 have been amended. Claims 1-13 are currently pending.

### *Double Patenting*

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Claims 1-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-37 of copending Application No. 09/738,199. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-14 are directed to the same invention as that of claims 1-37 of commonly assigned application (09/738,199). The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of

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the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

***Claim Rejections - 35 USC § 102***

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Castle (US2002/0077891).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Castle teaches obtaining a set of user information; obtaining a media request; receiving an electronic copy of the media request (see par. 0009, 0010); Castle teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (media on demand); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made

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available to the publisher for placement in the publication and stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014, [0017]]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said advertisement in response to querying the advertising provider for an electronic copy of the advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for publication (see par. [0018], [0031], [0032] ) see also (claims 1-37 for placing of the advertisement in the publication).

Regarding claims 2-4, Castle teaches prompting user to input a log-in code; retrieving the code; retrieving user profile; prompting user to register with media selection interface; communicating the profile to at least one advertising provider (see

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[0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service).

Regarding claims 5-7, Castle teaches locating an advertisement space in said electronic copy, assigning advertisement space, determining the dimension of the advertisement space determining the location of the space and receiving a set of advertisement space information (see par. [0016], [0017], [0021]).

Regarding claim 8, Castle teaches communicating set of user information to said advertising provider at the same the set of advertisement space information is communicated to said advertising provider (see par. [0014] to [0017], [0022] to [0024], [0032]).

Regarding claims 9-12, Castle teaches requiring user to log-in; retrieving the code; retrieving user profile; displaying a list of available media (see [0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service); obtaining a media request; communicating the request to service provider; determining a content provider for (see par. [0009], [0010]); Castle teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (see [0012], [0016], [0017]); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least

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one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014, [0017]]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said advertisement in response to querying the advertising provider for an electronic copy of the advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for publication (see par. [0018], [0031], [0032] ) see also (claims 1-37 for placing of the advertisement in the publication).

Regarding claims 13 and 14, Castle teaches a computer having a central processing unit, a memory, and at least one communications port (fig. 2); at least one advertisement database for storing advertisement data and associated user information; a listing of advertisement, a set of dimensions and set of user preference data (see par [0012] to [0016]); operational program for receiving a user information; for querying advertisement database and determining a bid amount (see par. [0012] to [0018]).

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Claims 1-14 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

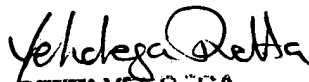
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

  
**RETTA YEHDEGA**  
**PRIMARY EXAMINER**